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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,002	12/10/2003	Susumu Uehara	113046.01	6339
25944	7590	12/15/2005	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			BOLDEN, ELIZABETH A	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/731,002	<b>Applicant(s)</b> UEHARA, SUSUMU	
	<b>Examiner</b> Elizabeth A. Bolden	<b>Art Unit</b> 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 10/172,997.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/10/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 10/172,997, filed on 18 June 2002.

It is noted that this application claims subject matter disclosed in prior Application No. 10/172,997, filed 18 June 2002. The applicants have inserted the reference to the prior application as the first sentence of the specification of this application. Applicant is requested to update this information since the application has now been allowed and published as U.S. Patent 6,753,281 B2, issued on 22 June 2004.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted 10 December 2003 was considered by the examiner.

### ***Claim Rejections - 35 USC § 102 and 35 USC § 103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Inoue, Japanese Patent Publication 60-221338.

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An English translation of JP 60-221338 was provided with the IDS (PTO –1449) this action. In reciting this rejection, the Examiner will cite this translation.

Inoue discloses an optical glass having overlapping ranges of components with instant claims 1 and 4-6. See page 5, line 23 to page 6, line 7. Inoue discloses that the optical glasses have overlapping ranges of refractive index and Abbe number with instant claim 1. See page 4, lines 3-6. Inoue teaches that the optical glasses do not show any signs of devitrification when held at temperatures above 950°C for 2 hours. See page 10, lines 8-16. The compositional ranges of Inoue are sufficiently specific to anticipate the glass composition recited in claims 1 and 4-6. See MPEP 2131.03. The property ranges of Inoue are sufficiently specific to anticipate the refractive index, Abbe number, and devitrification when held at temperatures above 950°C for 2 hours properties recited in claims 1. See MPEP 2131.03.

However, Inoue does not disclose any examples that anticipate claims 1-6.

Therefore, in the alternative to the § 102 rejection the reference discloses a composition that has overlapping ranges of components with the instant claimed glass, and overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

Since the composition of the reference is the same as those claimed herein it follows that the glasses of Inoue would inherently possess the same  $T_g$  and devitrification properties as recited in claims 1-3. See MPEP 2112.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kido et al., Japanese Patent Publication 10-226533.

A machine translation of JP 10-226533 and Derwent Abstract 1998-514986 accompany this action. In reciting this rejection, the Examiner will cite the translation and Abstract.

Kido et al. disclose an optical glass having overlapping ranges of components with instant claims 1 and 4-6. See Derwent Abstract and paragraph [0009]. The compositional ranges of Kido et al. are sufficiently specific to anticipate the glass composition recited in claims 1 and 4-6. See MPEP 2131.03.

However, Kido et al. do not disclose any examples that anticipate claims 1-6.

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Therefore, in the alternative to the § 102 rejection the reference discloses a composition that has overlapping ranges of components with the instant claimed glass, and overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

Since the composition of the reference is the same as those claimed herein it follows that the glasses of Kido et al. would inherently possess the same refractive index, Abbe number,  $T_g$  and devitrification properties as recited in claims 1-3. See MPEP 2112.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,558,316. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compositional and property ranges overlap. Overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

### ***Conclusion***

The additional references cited on the 892, specifically U.S. Patent 6,558,316, have been cited as art of interest since they are considered to be cumulative to the art relied upon in the rejections above.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Bolden whose telephone number is 571-272-1363. The examiner can normally be reached on 9:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**\*\* Please note that the Examiner, Elizabeth A. Bolden will be out of the office for an extended period of time starting on or about 19 January 2006 and returning approximately 10 February 2006. You can leave me a voicemail message, which I will try to check intermittently, otherwise please contact my supervisor Jerry Lorengo at the above telephone number. Sorry for this inconvenience. \*\***

  
**KARL GROUP**  
**PRIMARY EXAMINER**  
**GROUP 1755**

EAB

12 December 2005